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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,387	01/17/2002	Jian Ling Ding	17644-68	1539
33717	7590	09/20/2007		
GREENBERG TRAURIG LLP (LA) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404			EXAMINER GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER
			1615	
			MAIL DATE	DELIVERY MODE
			09/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/053,387

Applicant(s)

DING ET AL.

Examiner

Isis A. Ghali

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

Art Unit: 1615

### **DETAILED ACTION**

The receipt is acknowledged of applicants' amendment and request for RCE, both filed 07/02/2007.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/02/2007 has been entered.

Claims 1, 4, 9, 11, 12, 14, 15, 17 have been canceled.

Claims 2, 3, 5-8, 10, 13, 16, 18-38 are pending.

**The following restriction requirement is necessitated by applicants' amendment:**

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Art Unit: 1615

- I. Claim 16, drawn to composition comprising EPDM, butyl rubber and hydrophilic material, classified in class 424, subclass 448.
- II. Claims 32-38, drawn to composition comprising EPDM, polyisobutylene and hydrophilic material and further comprising ethylene propylene elastomer, hydrophilic particles, therapeutic agent, styrenic block copolymer and other additives, classified in class 424, subclass 448.

**The inventions are distinct, each from the other because of the following reasons:**

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different designs because invention I requires butyl rubber that is not required by invention II, and invention II requires polyisobutylene, ethylene propylene elastomer, hydrophilic particles, therapeutic agent, styrenic block copolymer and other additives that all not required by invention I.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Art Unit: 1615

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. John Wall on September 12, 2007 a provisional election was made without traverse to prosecute the invention of II, claims 32-38. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Further, claims 2, 3, 5-8, 10, 13, 18-31 have been previously withdrawn with traverse from consideration as being directed to nonelected invention.

Claims 32-38 are included in the prosecution.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1615

8. Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 fails to further limit claim 32 because claim 32 recites the composition comprising polyisobutylene and EPDM polymer, and claim 33 recites polyisobutylene and ethylene propylene elastomer which is broader than EPDM and inclusive to EPDM as evidenced by the "ELASOMER" from Wikipedia. The article "ELASTOMER" teaches that elastomer is used interchangeably with the term "rubber", and provides examples of elastomer including ethylene propylene rubber(EPM), claimed by claim 33, and EPDM polymer. Therefore, EPM is broader than and inclusive to the narrower species EPDM.

Regarding claim 34, the claim fails to further limit claim 32 because claim 32 recites "hydrocolloid material". Since the claims are interpreted in view of the specification, the specification disclosed hydrocolloid particles only in paragraph 0033. Therefore, the hydrocolloid materials recited by claim 32 are interpreted as hydrocolloid particles. Claim 34 is reciting particles again.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1615

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of 5,827,525 ('525), US 4,335,026 ('026), and US 4,551,490 ('490).

US '525 teaches pressure sensitive adhesive capable for adhering to moist surfaces in the form of hydrocolloid adhesive comprising hydrophobic rubber in which hydrophilic powders are dispersed. Hydrophobic adhesives included EPDM polymer, polyisobutylene and KRATON, which is SIS block copolymer, and hydrophilic powders included pectin and carboxymethyl cellulose (col.1, line 66 till col.2, line 18). EPDM polymer reads also on ethylene propylene elastomer as evidenced by the "ELASOMER" from Wikipedia. The article "ELASTOMER" teaches that elastomer is used interchangeably with the term "rubber", and provides examples of elastomer including ethylene propylene rubber(EPM), claimed by claim 33, and EPDM polymer. Therefore,

Art Unit: 1615

EPM is inclusive to the species EPDM. US '525 teaches the adhesive comprises active agents (col.3, lines 4-6).

Although US '525 suggested each of EPDM polymer, polyisobutylene and KRATON as hydrophobic polymers, however, the reference does not explicitly teach their combination. US '525 does not explicitly teach the percentage of ethylene and propylene in the EPDM polymer.

US '026 teaches an adhesive composition for application to the skin as an adhesive bandage and tape having decreased resistance to peel removal while maintaining high shear resistance in air and in water (abstract; col.1, lines 7-11; col.3, lines 50-55). The preferred adhesive composition comprises ethylene-propylene-diene monomer terpolymer wherein the ratio of ethylene to propylene is 3:1, i.e. 75% ethylene and 25% propylene (col.2, lines 57-61). The composition further comprises, styrene block copolymer in an amount of 25-42%, elastomer stabilizer, pigments, and anti-oxidants, which read on the active agent (col.2, lines 20-33, 42-44; col.3, lines 30-33; col.5, lines 27-29; col.5, examples I-III).

US '490 teaches medical grade adhesive resistant to erosion by moisture and body fluids, and it is non-irritating to the human skin (abstract; col.2, lines 28-36). The adhesive composition comprising polyisobutylene, styrene block copolymers, hydrocolloid gums, elastomer, active agents and additives (col.2, lines 53-60; col.3, lines 9-11, 21-37, 47-65; col.4, lines 8-10, 18-21, 40-32, 56-60; col.5, lines 55-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide hydrocolloid adhesive composition comprising



Art Unit: 1615

EPDM polymer and hydrophilic particles for adhering to moist surface as disclosed by US '525, and further add polyisobutylene, styrene block copolymer and elastomer as disclosed by US '490 motivated by the teaching of US '490 that adhesive composition comprising such elements is resistant to erosion by moisture and body fluids, non-irritating to the human skin, with reasonable expectation of having hydrocolloid adhesive composition comprising EPDM polymer, polyisobutylene, styrene block copolymer, elastomer and hydrophilic particles wherein the hydrocolloid adhesive composition is non-irritating to the skin and has enhanced adhesion to moist surfaces while resistant to erosion by moisture.

Additionally, one having ordinary skill in the art would have been motivated to use EPDM polymer that has the ratio of ethylene to propylene of 3:1 disclosed by US '026 in the composition produced by the combination of US '525 and US '490 because US '026 teaches that adhesive comprising EPDM polymer having this ratio of ethylene and propylene is preferred, and when combined with polyisobutylene and styrene block copolymers provides decreased resistance to peel removal while maintaining high shear resistance in air and in water, with reasonable expectation of having hydrocolloid adhesive composition comprising EPDM polymer having ratio of ethylene to propylene of 3:1, polyisobutylene, styrene block copolymer elastomer, and hydrophilic particles wherein the hydrocolloid adhesive composition is non-irritating to the skin and has enhanced adhesion to moist surfaces while resistant to erosion by moisture, and further has decreased resistance to peel removal while maintaining high shear resistance in air and in water.

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US '525, US '026 and US '490, and further in view of US 6,805,961 (961).

The combined teachings of US '525, US '026 and US '490 are discussed above. Although the combined teachings of the references suggested elastomer in the adhesive composition, however, the combination of the references does not explicitly teach the composition comprises ethylene propylene elastomer.

The specific claimed elastomer does not impart patentability to the claims, absent evidence to the contrary.

US '961 teaches an adhesive tape comprising amorphous polyolefin based on propylene that provides improved stress relaxation properties and flexibility of the tape (col.6, lines 1-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the adhesive composition comprising EPDM polymer, polyisobutylene, styrene block copolymers, hydrophilic material and elastomer as disclosed by the combined teachings of US '525, US '026 and US '490, and replace the elastomer by the amorphous propylene based polyolefin disclosed by US '961, motivated by the teaching of US '961 that the amorphous propylene based polyolefin provides improved stress relaxation properties and flexibility of the tape, with reasonable expectation of having adhesive composition comprising EPDM, polyisobutylene, styrene block copolymers, hydrophilic material and amorphous

Art Unit: 1615

propylene based polyolefin that has improved relaxation properties and flexibility, along with its moisture resistance properties.

***Response to Arguments***

13. Applicant's arguments with respect to claims 32-28 have been considered but are moot in view of the new ground(s) of rejection.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis A Ghali



**ISIS GHALI**  
**PRIMARY EXAMINER**